

Nominet UK Dispute Resolution Service

**DRS 00631**

**19 Entertainment Ltd -v- Mrs Kath Parker**

Decision of Independent Expert

**1. Parties**

Complainant: 19 Entertainment Ltd  
Address: 33 Ransomes Dock  
35-37 Parkgate Road  
London  
Postcode: SW11 4NP  
Country: GB

Respondent: Mrs Kath Parker  
Country: GB

**2. Domain Name**

19music.co.uk (“the Domain Name”)

**3. Procedural Background**

The complaint was lodged with Nominet electronically on 24 September 2002. Nominet validated the complaint on 30 September 2002, by then having received the complaint in hard copy (complete with ten supporting annexes). On the same day, Nominet contacted Mrs Kath Parker by email and post to inform her that a complaint had been lodged in relation to the domain name 19music.co.uk, which was registered in her name, and that she had until 22 October 2002 in which to lodge a response.

On 22 October 2002 Nominet received a Response (complete with five supporting annexes) in the names of “Mrs Kathleen Parker (Registrant) and Mr Stephen Christopher (Associate)”. This was immediately forwarded to the Complainant’s solicitor Miss Faye Hickman of Harbottle and Lewis, giving them until 31 October 2002 in which to file a reply.

On 31 October 2002 Nominet received a reply (including a further annex) from Harbottle and Lewis on behalf of the Complainant. This was forwarded the following day to the Respondent. At this point both parties were informed that an informal mediation stage would take place between 5 November 2002 and 19 November 2002 inclusive.

In accordance with Nominet’s Dispute Resolution Procedure para 7b, I have no information relating to the informal mediation. On 20 November 2002 Nominet wrote to both parties stating that it had not been possible to resolve the complaint by informal mediation, and inviting the Complainant to refer the matter for an expert decision by 4 December 2002.

Nominet received the fee for an expert decision on 2 December 2002.

On 2 December 2002 Claire Milne, the undersigned, (“the Expert”) confirmed to Nominet that she knew of no reason why she could not properly accept the invitation to act as expert in this case and further confirmed that she knew of no matters which ought to be drawn to the

attention of the parties, which might appear to call into question her independence and/or impartiality. Her appointment as Expert in the case was dated 9 December 2002.

#### **4. Formal/Procedural Issues**

##### **Respondent**

As already mentioned, the response was made in the joint names of “Mrs Kathleen Parker (Registrant) and Mr Stephen Christopher (Associate)”. It is Mrs K Parker’s name which appears on Nominet’s Whois database as registrant for the Domain Name, with Stephen Christopher cited as Administrative Contact. The name Kathleen Parker also appears on the website associated with the Domain Name (where it is offered for sale), with Stephen Christopher given as the person for interested parties to contact. However it is mainly Mr Christopher’s name that appears throughout the evidence supplied by both Complainant and Respondent.

Mrs Parker and Mr Christopher have provided a single postal address and a single email address for correspondence with Nominet, and have responded jointly. For the purpose of resolving this Complaint I therefore regard them jointly as the Respondent or Respondents. Any reference to either individual in what follows should be taken as a reference to the Respondent.

#### **5. The Facts**

From the uncontested evidence supplied, I piece together the following chronology of relevant events.

- a In 1985, Simon Fuller managed the hit “19” by Paul Hardcastle. On the strength of this, 19 Management Ltd and 19 Entertainment Ltd were incorporated that year.
- b In 1993, 19 Music Ltd was incorporated on behalf of Simon Fuller.
- c The 19 Group registered the domain name 19.co.uk on 27 June 1997. It continues to use this for its principal web presence and email addresses, giving access to all the individual businesses mentioned here, including 19 Music.
- d Simon Fuller and his 19 Group have been very successful in the pop music business. They have managed many well-known artists, and have branched out into various associated activities. They incorporated 19 TV Ltd in 1997, 19 Recordings Ltd and 19 Productions Ltd in 1998, 19 Merchandising Ltd in 1999 and 19 Songs Ltd in 2000.
- e Since the late 1980s, the Respondents have also been commercially involved in the music industry. However they have not had the same level of success.
- f On 28 May 2000 Stephen Christopher registered the domain name 19music.co.uk.
- g On 20 February 2001 Stephen Christopher sent an email to Jo McCormack at 19 Management. This email re-established an earlier business acquaintance between the two (pre-dating Ms McCormack’s employment with the 19 Group) and offered her a demonstration recording by a new artist. The email did not refer to domain names or trading names.
- h Sometime in March or April of 2001, Stephen Christopher called in at Jo McCormack’s office. The parties’ recollections of this incident differ.

- i On 14 May 2002 Stephen Christopher again emailed Jo McCormack, including the following text:

“I own a domain ///19music.co.uk and keep getting material and documents intended for Simons company ...example....the enclosed attachment from Jeff Chegwin which you can download from this e-mail. Usually I just delete stuff I receive for you or Simon or Nick etc but I will be putting the domain 19music.co.uk up for auction in the coming days and am concerned that a new owner might not be as trustworthy and could access wrongly directed stuff without any problem. Would you let Simon know that I would prefer for him to own this domain....it would be a lot safer ....and that I have it listed at present at \$62,000 (£37,000 sterling). Hope he goes for it...I’m quite concerned that your e-mails are sometimes forwarded with attachments to my domain.”

- j On 6 June 2002 Jo McCormack replied by email to Stephen Christopher, asking for details of Mrs Parker and pointing out that the domain name was currently advertised for sale on UK2net’s website for £7,000. This email includes the following text:

“Obviously any use of this domain name by Mrs Parker would be done so in bad faith and it is important that she understands the potential seriousness of this. To be honest we do not ever get into bidding with any third parties for domain names and only take action when there has been a clear act of bad faith.”

- k Stephen Christopher replied by email on the same day, including the following text:

“Kath Parker is my partner in 19 music which we set up after the release many, many moons ago after the Paul Hardcastle hit single “19”. 19 Music initially managed some acts but latterly has been the repository for copyright registrations for artists who wish some element of 3<sup>rd</sup> party security for their compositions. The current auction figure should read £37,000 GBP and UK 2 Net have been advised to amend their auction site information. There is absolutely No bad faith in force whatsoever and wherever we have received information or e-mails with downloadable content intended for yourselves we have immediately deleted the same WITHOUT OPENING to protect your company integrity.”

- l On 11 July 2002 Harbottle and Lewis wrote to the Respondent on behalf of the Complainant, requesting signature of an enclosed undertaking to transfer the Domain Name to the Complainant in return for reimbursement of its official registration costs. This letter maintains that:

- Mr Christopher has provided no evidence of his alleged use of the 19 Music name, and investigations have revealed no evidence of his involvement in the music industry.
- The Respondent is holding the Complainant to ransom by demanding an extortionate amount for assignment of the Domain Name, which is “confusingly similar” to the brand under which the Complainant operates, and this is illegal.
- The receipt by the Respondent of emails intended for the Complainant is evidence that the public has already been misled, which would support proceedings for passing off.

The letter concludes with a threat of court proceedings if the Respondent does not return the signed undertaking by 19 July 2002.

- m On 16 July 2002 the Respondent replied to this letter, arguing in strong terms that the points above are mistaken, labelling the offer of registration costs as “derisory”, and offering the Domain Name for £27,500. A reference is made to possible tabloid interest in any court case.
- n On 30 July 2002 Harbottle and Lewis replied, reiterating their previous views and giving the Respondent until 9 August to accept the earlier offer.
- o On 7 August the Respondent replied, repeating earlier material and also:
  - Including a copy of part of an email received. This consists of an advertisement for concerts on 20 May starring “the Russian teenage sensation Tina Japaridze”. Handwritten at the foot of the page is “Emailed to 19music.co.uk”.
  - Asserting that any attempt to restrict use of the Domain Name would be a restriction of trade and threatening retaliatory court proceedings.
  - Stating that the online auction of the Domain Name would end at midnight on 16 August, and that the Respondent would be away from 17 August to 27 September. The price of £27,500 is repeated.
- p A printout dated 12 August from UK2net’s website shows 19music.co.uk on offer at £7,000 and recurringdream.co.uk at £37,000.
- q On 1 September UK2net emailed the Respondent to say that an offer of £7,000 had been received for 19music.co.uk.
- r A printout of a search for 19music.co.uk on UK2net’s auction website auction2net, dated 23 September 2002, shows it as on offer for 100,000 (no money unit given).
- s Enclosed with the papers is a copy of the webpage found on 30 September at the URL [www.19music.co.uk](http://www.19music.co.uk). This shows 19music.co.uk on offer through UK2net at £7,000, together with recurringdream.co.uk at £37,000 (the same as at 12 August).

## **6. The Parties’ Contentions**

### **Complainant:**

The Complaint falls into three main parts.

- a) A recital of Simon Fuller’s activities and achievements in the music industry, all of which are agreed by the Respondent. The incorporation of 19 Music Limited in 1993 is mentioned in a long list of other companies in the 19 Group. This part closes with the assertion:

“The mark “19” is at least similar to the Domain Name 19MUSIC if not identical to it, given that the “MUSIC” part of the Domain Name is purely descriptive of the industry with which the complainant is most closely connected. The word “MUSIC” therefore does not serve to distinguish these goods from those offered by another entity.”

- b) A history of the Complaint, most of which has already been summarised above.
- c) The following points are offered as evidence of Abusive Registration.

- i) The Respondent has provided no evidence of his alleged involvement in the music industry using the name “19”, nor have other investigations revealed any evidence of this.
- ii) Since 16 May 2002, the Respondent has been offering the Domain Name for sale at prices which have varied, but which have all in the Complainant’s view been well in excess of any possible outlay associated with acquiring the Domain Name.
- iii) The emails received by the Respondent which were intended for the Complainant are cited as evidence of significant confusion to third parties.
- iv) It is suggested that this case is parallel to *penquin.co.uk* (DRS 0114), in which a similar negotiating tactic to that employed by the Respondent in this case was found to amount to an abusive use of the domain name. The threat in both cases is that confusion will continue if the rights owner does not buy the domain name.

**Respondent:**

The Response may be summarised as follows.

- a) The Respondent has itself a wholly legitimate claim on the Domain Name, as a result of its long-standing involvement in the music industry and specifically:
  - i) Its operations in the early 1990s under the business name “19’s Music”.
  - ii) Having been invoiced in the late 1980s as 19SOUNDS. No documentary evidence is supplied of (i) or (ii), but the Respondent claims that it could produce affidavits certifying these activities, given time to do so.
  - iii) A recent copyright registration venture. Copies of two unsigned papers purporting to be copyright certificates are annexed, both bearing the name 19music.co.uk, one dated 15 May 2002 for Andrew Hignett, the other dated 17 June 2000 for Shairon “R”.
- b) The Complainant’s activities are now diversified from music, into for example television, publishing and merchandising. Disagreeing with the Complainant’s view that ““19” is at least similar to the Domain Name “19MUSIC” if not identical with it”, the Respondent states: “The word MUSIC adequately describes our long-standing involvement in the Industry and whilst we have not had the same level of success commercially as the complainant appears to have achieved it would be unlawful to discriminate against us on those grounds”.
- c) The 19 Group have been aware of the Respondent’s ownership of 19music.co.uk since Stephen Christopher’s visit to Jo McCormack’s office in March or April 2001, when he mentioned it briefly as a coincidence.
- d) There has not been significant confusion to third parties. In fact, only one email has been received that was intended for the Complainant (although several copies of this arrived during May 2002). In any case, the *penquin.co.uk* case is irrelevant because in that case the Respondent was a domain name dealer.

- e) This Respondent is not a domain name dealer. They are simply exercising their right to sell their own property for its market value. The Domain Name was transferred to Kath Parker for £11,500 on 6 September 2000, and the partners decided to sell it in January 2002. UK2net have consistently advertised it at the wrong starting price – they have been instructed to offer it for £27,000. It is of no concern to the Respondent who ultimately becomes the new owner of this domain.

**The complainant's reply:**

- a) The reply points to the continuing lack of evidence of the Respondent's use in the music industry of any name including 19, although he has been aware of the potential conflict over 19music.co.uk at least since 6 June. It states that the purported copyright certificates supplied are not generally recognised as such.
- b) Jo McCormack has no recollection of Stephen Christopher having mentioned the Domain Name to her when he dropped in during March or April 2001. As soon as she became aware of this matter in May 2002, she took prompt action, and she would have done so earlier had she been so aware.
- c) The reply points to inconsistencies in the Respondent's correspondence over the number of emails received, and maintains the original claim that there was confusion.
- d) The reply claims that the fact that the name recurringdream.co.uk is also being offered for sale by the same parties contradicts the Respondent's assertion of not being a domain name dealer.

**7. Discussion and Findings**

For the complaint to succeed, according to paragraph 2 of the Policy, the Complainant must prove to the Expert that on the balance of probabilities:

- i) the Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and
- ii) the Domain Name, in the hands of the Respondent, is an Abusive Registration; that is, as defined in paragraph 1 of the Policy, a Domain Name which either:
- a. was registered or otherwise acquired in a manner which, at the time when the registration or acquisition took place, took unfair advantage of or was unfairly detrimental to the Complainant's rights; OR
  - b. has been used in a manner which took unfair advantage of or was unfairly detrimental to the Complainant's Rights.

I shall discuss in turn issues relating to the Complainant's Rights and to Abusive Registration. First, however, I must comment that the way the Complaint is presented has not helped me to do this. Both parties to this dispute seem to have regarded their recourse to Nominet as a continuation of their previous correspondence in relation to passing off and restriction of trade. They do not appear to have understood the need to adapt their arguments to Nominet's Procedure and Policy.

**Complainant's Rights**

In 1.9 of the Complaint, it is stated that the 19 Group incorporated 19 Music Limited in 1993. No evidence is supplied, but I accept that this means that the Complainant has Rights in the Name (in common with other Experts, I do not regard the space as significant). Simon Fuller's achievements and reputation are not relevant to this conclusion.

I certainly cannot accept the strange contention that "19MUSIC" is identical to "19", but luckily this is not necessary in order to establish Rights. Nor do I need to consider the level of similarity between "19" and "19MUSIC".

### **Abusive Registration**

This leaves the second question raised above, that is, whether the Domain Name, in the hands of the Respondent, is an Abusive Registration.

### **Paragraph 3 of the Policy**

The Complainant's evidence and argument appear to relate only to one of the non-exhaustive list of factors at paragraph 3 of the Policy, namely to 3 a) ii): circumstances indicating that the Respondent is using the Domain Name in a way which has confused people ... into believing that the Domain Name is registered to...the Complainant. The contention is that mis-delivered emails point to such confusion.

The only email to the 19music.co.uk domain of which I am aware is a commercial circular. I have the following comments on this.

- a It is commonplace for such circulars to be replicated, and I find it probable that more than one copy of essentially the same email was received. This helps to account for the inconsistent statements about the number of emails in question.
- b No appreciable harm is caused by the non-receipt of such circulars (indeed, they are widely regarded as "junk" and avoided, or deleted unread). In any case, there is an excellent chance that the 19 Group itself directly received at least one copy of this circular.
- c There is no evidence that the email in question was actually intended for the 19 Group rather than for the Respondent, who is also interested in music.
- d Even if the email address including 19music.co.uk was used by mistake, I cannot see this as evidence of confusion on the part of the sender. It is normal for bulk emailing of commercial circulars to lead to a proportion of non-deliveries and mis-deliveries. Their targeting is often imprecise. It is more likely to be regarded as a success if the circular reaches any individual who reads the content, than as a failure if the circular does not reach a named individual.

I therefore find that 3 a) ii) is not relevant to this case (and hence, neither is the *penquin.co.uk* case referred to).

The factors listed in 3 a) i) all relate to the purpose or primary purpose for which the Respondent has acquired the Domain Name. Unfortunately, I have no information at all from either party on the circumstances around the time of acquisition. I therefore cannot find any of 3 a) i) to be relevant.

The Complainant may intend its comment on the parallel sale of the domain name recurringdream.co.uk to be taken as evidence for 3 a) iii) (a pattern of Abusive Registrations). I note this point, but can give it little weight, since:

- a I have not investigated the status of the registration of recurringdream.co.uk (though I notice that [www.recurring-dream.co.uk](http://www.recurring-dream.co.uk) is the website of a band).
- b Even if recurringdream.co.uk were an Abusive Registration, one other occurrence hardly amounts to a “pattern”.

Paragraphs 3 a) iv) and 3 b) are not relevant in this case. The grounds in paragraph 3 are therefore exhausted.

#### **Paragraph 4 of the Policy**

I turn now to paragraph 4 of the Policy, *How the Respondent may demonstrate in its response that the Domain Name is not an Abusive Registration*. Again there is a non-exhaustive list of factors, the only one of which the Respondent seems to refer to being 4 a) i) B: that before being informed of the Complainant’s dispute, the Respondent has been commonly known by the name or legitimately connected with a mark which is identical or similar to the Domain Name.

This is a point on which the two parties make directly opposed claims. I have the following comments:

- a Like the Complainant, I note the shortage of hard evidence for the Respondent’s claims. (I feel I cannot rely on two unsigned purported copyright certificates, of a kind said not to be generally recognised in the industry and unsupported by statements from the third parties named on them).
- b This of course on its own does not make these claims false. I have sympathy with the Respondent’s point that greater business success does not in itself create a greater entitlement to a disputed name.
- c I note however that, whatever his claims to the name, the Respondent seems to have no interest at all in using the Domain Name in the music business, nor does he state that he has ever had any such interest. His only current interest in the name appears to be in selling it for the highest possible price.

#### **Abusive Registration**

Since neither party has demonstrated its case through the factors in paragraphs 3 and 4, I return now to the definition of Abusive Registration.

Again, the first part of the definition refers to the time of acquisition, about which, as already stated, I have no information.

I am therefore left with the second part, and ask whether the Domain Name has been used in a manner which took unfair advantage of or was unfairly detrimental to the Complainant’s Rights.

The only way in which the Domain Name has been used, to my knowledge, is that since May 2002 it has pointed to an auction site where it has been displayed for sale at various prices. One thing emerges clearly from the confusing and sometimes inconsistent papers associated with this case: the Respondent wishes to sell this Domain Name for a high price (and has apparently already received one offer of £7,000).

Why should the name 19music.co.uk command a high price in the market? According to the Respondent, the Complainant is much more successful than the Respondent. Presumably his "19" mark (and associated marks) are much better known than any similar marks that properly belong to the Complainant. Therefore, I conclude that the selling price of the Domain Name, whoever it may be sold to, will be influenced much more by the Complainant's reputation than by the Respondent's.

The Respondent has plainly been aware of the Complainant's relevant reputation, at least since May 2002 if not since the original registration of the Domain Name. I believe that his continuing advertisement for sale of this name (and his apparent ability to sell it for at least £7,000) point to his gaining a potential financial advantage from the name, which is knowingly built on the Complainant's reputation rather than on his own. I consider this to be an unfair advantage, and consequently find the registration to be abusive.

For completeness, I add that I do not see that the Name has been used in a manner which has been detrimental to the Complainant's Rights, whether unfairly or otherwise. No business has been conducted using the Name, whether at a website or as an email address; there can have been no confusion, dilution or other harm done.

## **8. Decision**

In light of the foregoing findings, namely that the Complainant has rights in respect of a name or mark which is identical to the Domain Name and that the Domain name, in the hands of the Respondent, is an Abusive Registration, I decide in favour of the Complainant. The Complainant's requested remedy is transfer, and accordingly I direct that the Domain Name be transferred to the Complainant.

---

Claire Milne

20 December 2002  
Date